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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,415	12/03/2003	Wen-Shan Huang	3313-1076P	8785
2292	7590	09/22/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			WARREN, DAVID S	
			ART UNIT	PAPER NUMBER
			2837	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,415

Applicant(s)

HUANG ET AL.

Examiner

David S. Warren

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 10 - 20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 3-8, 10 - 20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 – 8, and 10 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unno et al. (6,076,063). Regarding claims 1 and 8, Unno discloses a digital music conversion device employing MPEG 1 Audio Layer 3 (col. 11, third paragraph – the Applicant's use of a 12:1 compression ratio is the industry standard as Applicant admits on Specification page 1, lines 11 – 13), the use of a first transmission interface (10, an interface on the CD music player is inherent, otherwise the data would not be able to accessed to be converted, e.g., this could be the jack on the CD player that element 10 plugs into), a recording medium (8), a format converting module (elements 2, 4, and 5 taken together), and a second data transmission interface (this is inherent if the converted data is to be stored on the semiconductor memory 8). The “compression” of Unno requires less storage space. Unno discloses a “small light weight” device, the Examiner maintains this to be synonymous with “portable.” Furthermore, Unno discloses the use of a control module (elements 2 and 5 taken together), a decoding module (4, which converts from a first format to a second format, i.e., “compression” is

Art Unit: 2837

synonymous with conversion), and a buffer unit (6). Finally, Unno discloses that the recording medium may be external (i.e., not included within the digital music conversion device – see Abstract). While Unno discloses the use of all components and uses an arrangement that accomplishes precisely the same task (converting music audio formats and saving the result) as the Applicant, however, Unno does not disclose the exact arrangement of parts (e.g., the first and second data transmission interfaces, the format converting module, nor the use of PCMCIA interfaces for both the first and second data transmission interfaces). The Examiner deems the teachings of Unno and the Applicant's claimed arrangement of parts to be functionally equivalent. It would have been obvious to one of ordinary skill in the art to modify the teachings of Unno to obtain Applicant's claimed arrangement of elements. The motivation for making this modification is to provide circuit design layout compatible with manufacturing optimization and protocol (as well as providing a digital circuit capable of efficient processing). Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Regarding claims 3 and 10, Unno discloses the use of a display (11) and a user control (col. 7, lines 22 – 25; the use of “keys” are functionally equivalent to providing for user control). Regarding claims 4 and 11, Unno discloses the use of the use of DSP (digital signal processing) chips are well-known within the audio compression art and are shown by Unno (col. 5, first paragraph; the Examiner acknowledges that Unno uses the DSP for a different purpose). Regarding claims 5, 6, 12, 13, and 16 – 18, Unno discloses the use of PCMCIA interfaces and memory cards (col. 9, lines 46 – 55). Regarding claims 14, 15,

Art Unit: 2837

and 19, the use of USB and IDE interfaces are notoriously well-known. Official Notice is hereby taken that USB and IDE interfaces are well-known and within the scope of one of ordinary skill in the art. Regarding claims 7 and 20, Unno discloses the use of a flash memory card (18).

Response to Arguments

2. Applicant's arguments filed July 5, 2006 have been fully considered but they are not persuasive. The Applicant argues that Unno does not disclose the use of ~~MPEG~~ *MPEG* Audio Layer 3 compressed at a 12:1 ratio. The Examiner does not concur. Unno discloses using any MPEG format (compression at 12:1 ratio is an industry standard, as the Applicant admits in the specification, page 1). The Applicant argues that Unno does not teach the use of a control module nor a decoding module. The Examiner addressed these issues in the previous Office Action – however, the Applicant merely states that these features are not found in Unno without any reason given as to why the Examiner's previous assertion is inappropriate. Therefore, the Examiner will maintain these assertions, i.e., that Unno does show both a control module and a decoding module.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

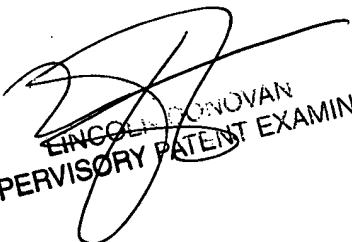
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Warren whose telephone number is 571-272-2076. The examiner can normally be reached on M-F, 9:30 A.M. to 6:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on 571-272-2837. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dsw


LINCOLNE DONOVAN
SUPERVISORY PATENT EXAMINER